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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YI-MIN WANG, PARAMVIR BAHL,
and WILF G. RUSSELL

Appeal 2007-2388
Application 09/887,413[1]
Technology Center 2100

Decided: February 19, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, C., *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Application filed June 21, 2001. The real party in interest is Microsoft Corporation.

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-42 entered April 11, 2006. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm and also use our authority under 37 C.F.R. § 41.50(b) to enter a new ground of rejection of claims 35-42 under 35 U.S.C. § 101.

A. INVENTION

Appellants invented a system, method, and computer readable medium directed to a centralized alert delivery system that receives alerts from multiple alert sources and then delivers the received alerts to the user according to one or more specified delivery modes. (Spec., Abstract.)

B. ILLUSTRATIVE CLAIMS

The appeal contains claims 1-42. Claims 1, 16, 28, and 35 are independent claims. As best representative of the disclosed and claimed invention, claims 1, 10, 16, and 35 are reproduced below:

1. A method, comprising:
   receiving an alert for a user from one of multiple alert sources;
   mapping the alert to a delivery mode; and
   transmitting the alert to the user according to the delivery mode.

10. The method as recited in claim 1, wherein:
    mapping the alert to the delivery mode further comprises:

mapping the alert to a primary delivery block specifying a first delivery action, and a second delivery block specifying a second delivery action; and

transmitting the alert to the user according to the delivery mode further comprises:

transmitting the alert to the user according to the first delivery action; and

transmitting the alert to the user according to the second delivery action if transmitting the alert to the user according to the first delivery action is unsuccessful.

16. A centralized alert delivery system, comprising:

an input/output (I/O) module configured to receive alerts from multiple alert sources;

a mapping module configured to map an alert to a delivery mode; and

a communications layer that interfaces to one or more communications modules, the communications layer being configured to receive the mapped alert and deliver the alert via a communications module according to the delivery mode associated with the alert.

35. One or more computer-readable media containing computer-executable instructions that, when executed on a computer, perform the following:

receiving an alert from one of a plurality of alert sources;

determining a delivery mode which specifies a delivery method by which the alert should be forwarded to a user; and

transmitting the alert to the user according to the delivery mode.

C. REFERENCE

The single reference relied upon by the Examiner in rejecting the claims on appeal is as follows:

Wagner	US 6,092,102	Jul. 18, 2000

D. REJECTION

The Examiner entered a Final Rejection on April 11, 2006 with the following rejection which is before us for review:

Claims 1-42 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wagner.

II. PROSECUTION HISTORY

Appellants appealed from the Final Rejection and filed an Appeal Brief (Br.) on August 8, 2006. The Examiner mailed an Examiner's Answer (Answer) on November 27, 2006. Appellants filed a Reply Brief (Reply Br.) on January 24, 2007.

III. ISSUE

Whether Appellants have shown that the Examiner erred in rejecting claims 1-42 as being anticipated by Wagner.

IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Claim Construction

1. The Specification discloses that "alert" is defined as "an electronic transmission, or delivery, of user-subscribed information to a user. . . . the user may instead register, or subscribe, to a service to receive alerts upon the occurrence of certain events." (Spec., 2.)

2. In the Specification, "[t]he system 200 includes information alert services 202, in this example MSN MOBILE 204, E*TRADE 206 and CNN/SI 208. The system 200 also includes personal alert sources 210, for example, Web communities/data stored 212, a user location system 214, a home networking system 216 and a desktop assistant 218." (Spec. 15.)

Wagner

3. Wagner discloses that "[t]he notification system 8 includes an information receiving function 22 of the information processing system 2 for receiving the information 16 as received information; . . . the clinical event monitor 4 which analyzes the stored information to determine an event (E) 18 and generate an alert 26 including a message data structure 27 having a message . . ." (Col. 6, ll. 23-35.)

4. Wagner discloses that "Table III shows an exemplary Type 1 preference matrix, such as employed by database 138, for a particular user.

. . . all labs tests . . . are communicated, for the particular user, using a 2-way fail-safe pager communication channel . . ." (Col. 11, ll. 59-66.)

5. Wagner discloses that "the data reception sub-system 48 receives information from a data generation sub-system 52, such as a service which provides newly published articles (e.g., from newspapers, magazines, medical journals) or the clinical information system of an affiliated enterprise, . . . and the data reception sub-system 50 receives information from a data generation sub-system 54, such as a laboratory information system or radiology information system . . . the sub-systems 44, 46, 48, 50 are processor based and employ suitable open protocols, such as TCP/IP, for communication with the database 24 over the communication network 42." (Col. 7, ll. 15-37.)

6. Wagner discloses that "[i]n addition to the exemplary preferences of Table III, it will be appreciated that the user might prefer e-mail or ToDo List communications at certain times of the day, and page communications at other times. Similarly, surgeons may be interested in receiving only articles on new surgical techniques, while pharmacists may be interested in receiving only articles on new drugs." (Col. 12, ll. 23-29.)

7. Wagner discloses that "for fail-safe communication channels, the communication channel manager 124 accepts an acknowledgement 125 of receipt of the message 38 from the user of the fail-safe communication channel. If the acknowledgement 125 is not provided by the user within a predefined time, then the message 38 is resent to the user and the process of

checking for the acknowledgement 125 is repeated." (Col. 14, ll. 39-46; Table V.)

V. PRINCIPLES OF LAW

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The scope of patentable subject matter under section 101 is broad, but not infinitely broad. "Congress included in patentable subject matter *only* those things that qualify as 'any … process, machine, manufacture, or composition of matter, or any … improvement thereof….'" *In re Warmerdam*, 33 F.3d 1354, 1358 (Fed. Cir. 1994) (quoting 35 U.S.C. § 101) (emphasis added). Thus, "[d]espite the oft-quoted statement in the legislative history of the 1952 Patent Act that Congress intended that statutory subject matter 'include anything under the sun that is made by man,'[citation omitted], Congress did not so mandate." *Id.*

VI. ANALYSIS

Grouping of Claims

> "When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (2006).[2]

In the Brief, we find that Appellants are essentially arguing three separate groups of claims.

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[2] We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

Firstly, Appellants argue claims 1-9, 11-15, and 35-42 as a group, because Appellants merely repeat the same argument made for claim 1 for all of the claims in this group. (Br. 14 and 20.) Thus, the Board selects representative claim 1 to decide the appeal for this group. Accordingly, the remaining claims in this group stand or fall with claim 1.

Secondly, Appellants separately argue claim 10. (Br. 14-16.)

Thirdly, Appellants argue claims 16-34 as a group, because Appellants merely repeat the same argument made for claim 16 for all of the claims in this group. (Br. 17-19.) We will, therefore, treat claims 17-34 as standing or falling with claim 16. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young,* 927 F.2d 588, 590 (Fed. Cir. 1991).

The Board's Claim Construction

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

To determine whether Wagner anticipates claims 1-42, we must first determine the scope of the claims. Our reviewing court stated in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005), *cert. denied, sub nom. AWH Corp. v Phillips*, 126 S. Ct. 1332 (2006): The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," *Markman*, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." *Id.* at 979. As we stated in

Vitronics, the Specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." 90 F.3d at 1582.

Upon our review of Appellants' claimed limitations "alert" and "alert sources" in light of Appellants' Specification, we conclude the following:

Initially, we note that Appellants are contending that Wagner's event monitor (4) describes a single alert generating source (Br. 13-14). However, although Wagner uses the term "alert" and also uses an event monitor (4) for generating such an "alert" based on received information (FF 3), we find that Appellants' claimed "alert" is far broader than Wagner's "alert".

For instance, while Wagner's "alert" includes a message data structure having a message and partial or complete delivery instructions (FF 3), Appellants define "alert" as "an electronic transmission/delivery of user-subscribed information" (FF 1). Thus, we find that the claimed "alert" reads on any electronically transmitted, user-requested information.

Secondly, Appellants define "alert sources" as including Web communities/data stored, a user location system, a home networking system, and a desktop assistant (FF 2). Thus, we find that the claimed "alert sources" includes any source which can transmit information electronically.

The Anticipation Rejection

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

Regarding Claim 1

Appellants contend that "Wagner does not describe 'receiving an alert for a user from one of multiple alert sources,' as claimed." (Br. 11; Reply Br. 2.) Appellants further contend that "the 'sources' described by Wagner (e.g., a la[b], news service, or individuals such as radiology staff) generate clinical *information,* from which alerts are derived, and are therefore not, in and of themselves, *alert* sources." (Reply Br. 3.)

The Examiner made the following findings:

> It is first noted that this claim does not require multiple alerts, but rather, multiple sources. Claim 1 clearly invokes the generation of at least one alert that may [be] derived from multiple potential sources. . . . The alerts originate from multiple sources, such as labs, news services and radiologists (col. 11, lines 62-67; col. 7, lines 15-20; col. 6, lines 4-7).

(Answer 8.)

We agree with the Examiner.

For example, Wagner discloses information being generated from various sources, e.g., labs, newspapers, magazines, and a radiology information system. Furthermore, Wagner's information is received via

various electronic means, e.g., 2-way pagers and processor based using TCP/IP protocols (FF 4-5). Additionally, Wagner discloses that its users can choose the type of information that they are interested in receiving (FF 6). As a result, Wagner's user can designate the type of information that will be eventually received. We conclude that such a mechanism is in essence a user-subscription feature. Therefore, we find that Wagner's electronic information from various sources reads on Appellants' "alert" and "alert sources" which, as noted *supra,* encompass any electronically transmitted user-requested information from multiple sources.

We find that Wagner discloses the above noted disputed features of claim 1. Therefore, we find that the Appellants have failed to show error in the Examiner's rejection. Therefore, we affirm the rejection of claim 1 and of claims 2-9, 11-15, and 35-42, which fall therewith.

Regarding Claim 10

Appellants contend that "Wagner only describes re-transmitting an alert using the same delivery method, and not 'transmitting the alert to the user according to the second delivery action if transmitting the alert to the user according to the first delivery action is unsuccessful,' as recited in claim 10." (Br. 16.) Appellants further contend that "[t]here is nothing in Table V to indicate that, 'when the primary delivery block requiring the first delivery action (immediate delivery) fails, the data in the secondary block will initiate

the second delivery action (fail safe mode),' as the Examiner contends."
(Reply Br. 6.)

The Examiner made the following findings and conclusion:

> Examiner maintains that this feature is clearly taught in reference to Table V and col. 14, lines 39-46. The first delivery action is immediate delivery of a message. If this fails, then the message is re-sent according to the fail-safe routine, where the message is re-sent repeatedly until acknowledged. It should also be particularly noted that the term 'first delivery action' could simply refer to the first initial transmission and the second delivery action could refer to the next subsequent transmission.

(Answer 9.)

We agree with the Examiner. Claim 10, reproduced *supra*, recites, *"transmitting the alert to the user according to the second delivery action if transmitting the alert to the user according to the first delivery action is unsuccessful."* In Appellants' Specification, delivery actions specify a delivery mode (i.e., e-mail, instant messaging or short message system (SMS) messaging), whether an acknowledgement to the alert is expected, and a time to wait for the acknowledgement (Spec., Abstract).

Although Appellants' claim 10 requires a first and second delivery action, there is no requirement that the delivery actions be different from each other. According to Appellants' Specification, delivery actions specify a delivery mode, whether an acknowledgement to the alert is expected, and a time to wait for the acknowledgement (*Id.*)

Wagner discloses an embodiment that resends the message if an acknowledgement of receipt is not received within a predefined time (FF 7). Thus, we find that Wagner discloses first and second delivery actions (initial transmission and re-transmission) that each includes a delivery mode, an indication of whether an acknowledgement is expected, and a time to wait (a predefined time) for the acknowledgement, whereby the second transmission is made if the acknowledgement is not provided in the first transmission.

We find that Wagner discloses the above noted disputed features of claim 10. Therefore, we find that the Appellants have failed to show error in the Examiner's rejection. Therefore, we affirm the rejection of claim 10.

Regarding Claim 16

Appellants contend that "Wagner does not describe, 'an input/output (I/O) module configured to receive alerts from multiple alert sources,' as recited in claim 16. . . . The information (20) that is received in the Wagner system is not an alert, but rather, information that can be analyzed and from which an alert may be generated." (Br. 17-18.)

The Examiner found that the claimed input/output module is equivalent to the overall system (8) in Fig. 1 of Wagner (Answer 9). We agree. Appellants have not demonstrated that this finding is in error. Furthermore, Appellants arguments regarding the multiple alert sources have already been addressed *supra.*

We find that Wagner discloses the above noted disputed features of claim 16. Therefore, we find that the Appellants have failed to show error in the Examiner's rejection. Therefore, we affirm the rejection of claim 16 and of claims 17-34, which fall therewith.

VII. NEW GROUND OF REJECTION

In addition to affirming the Examiner's rejection of claim 1-42 under § 102(e), this decision, pursuant to our authority under 37 C.F.R. § 41.50(b), contains a new ground of rejection.

Specifically, claims 35-42 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claim 35, reproduced *supra*, is representative.

For example, claim 35 is directed to "[o]ne or more computer-readable media…" and Appellants explicitly states that the "computer-readable media may comprise . . . 'communications media'. . . 'Communication media' typically embodies computer readable instructions, data structures, program modules, or other data in a modulated data signal, such as carrier wave or other transport mechanism." (Spec., 14.)

We find that Appellants' description of a 'computer readable media' explicitly implicates the use of carrier waves and signals. That said, the issue, quite simply, is whether a claimed computer readable media that is broad enough to include transmission-type media – a media that includes carrier waves and signals – is statutory subject matter. A carrier wave or

1signal is not statutory subject matter because it does not fall within any of
2the four categories of statutory subject matter. *See In re Nuijten,* 500 F.3d
31346, 1357 (Fed. Cir. 2007). In this instance, claim 35 includes both
4statutory and non-statutory subject matter that, according to recent proposed
5USPTO interim guidelines, must be amended to recite solely statutory
6subject matter.[3]

7 Even if as carrier wave or signal could be considered to be an article
8of manufacture, however, we find that such a carrier wave or signal does not
9operate as the claimed computer readable media. Claim 35, for example,
10recites a computer readable media having instructions for causing a
11computer to execute a method. As a result, it is our view that the computer
12cannot perform the claimed functions while the instructions are within a
13carrier wave or a signal. In other words, the information, while on the
14carrier wave or signal, is unavailable to the computer for performing the
15functions recited in claim 35.

16 For the above reasons, we find that claim 35 recites non-statutory
17subject matter. The "media" of claims 36-42 share the same interpretations
18as discussed *supra* for "media" in claim 35. Thus, for the reasons *supra*, we
19conclude that claims 36-42 are also directed to non-statutory subject matter.

65[3] *See also* "Interim Guidelines for Examination of Patent Applications for
66Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. Office 142, Annex
67IV(C)(2)(Nov. 22, 2005) ("[A] claim that can be read so broadly as to
68include statutory and nonstatutory subject matter must be amended to limit
69the claim to a practical application.").
70
71

37 C.F.R. § 41.50(b)

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) as to the rejected claims):

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner …
>
> (2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record …

VIII. CONCLUSIONS

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims.

Thus, claims 1-42 are not patentable.

However, since we have entered a new ground of rejection against claims 35-42, our decision is not a final agency action.

IX. DECISION

In view of the foregoing discussion, we affirm the Examiner's rejection of claims 1-42 and also enter a new ground of rejection for claims 35-42 under 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED
37 C.F.R. § 41.50(b)

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